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| EXAMINER | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,238

Applicant(s)

MORRIS-JONES ET AL.

Examiner

Jerome Grant II

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Detailed Action

1.

Rejections Under Section 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 7, 13, 14, 16, 17, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claims 6 and 7, there is no support for use of a tag in a cell phone or PDA. The specification fails to teach how a tag would be placed and utilized in such devices. The specification at para. 45 is inadequate to provide a teaching as to how the tag is configured in concert with the PDA and cell phone.

Does applicant suppose that its use is well known in the art ?

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With respect to claims 13 and 14, there is inadequate support in the written specification for the use of barcodes and glyph codes to serve as tag information. While it is well known in the art to use these types of codes for the purpose of providing machine readable information for performing a machine process, applicant has not provided enough disclosure to suggest that there is something novel about the barcodes or glyph codes that are used in the present invention.

With respect to claim 16 and 17 the present invention does not provide an enabling disclosure for the use of fax numbers or e-mail addresses that the print job is sent to. There is no teaching or recitation of elements that suggests that there is any communication of the print job to the fax number or email addresses. However, this limitations is well known in the art and perhaps, applicant has not provided a teaching in view of the fact that it is well known.

With respect to claims 21 and 22, there is insufficient support for the use of a tag information over the internet. How would the tag information be communicated over the Internet. By what device would in the information be converted and how ?

With respect to the broach, tie clip and pen, how would the tag be associated with these devices. Is the tag information physically attached to the clip, for example, or is it incorporated inside of the clip so as to be inconspicuous.

2.

Claims 1-3 and 5-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 has been amended to include that tag information is incorporated into a print job. This limitation is not supported in the written specification.

At paragraph 21 of the specification, it states that the tags are incorporated in clips, pins, containers and business cards but not in a print job.

Hence applicant is claiming subject matter for which there is no support.

Correction is required.

3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Shahindoust.

With respect to claim 1, Shahindoust teaches a method for completing a print job (steps 321, 323 and 325 of figure 3), comprising: delivering (step 321) at least one print job to a printing device 114; bringing a tag (smart card 102) containing information regarding the print job into close proximity to the printing device so that the device receives the information from the tag (step 313); using the information received from the tag to complete the print job, see para. 17, lines 18-28.

With respect to claim 2, Shanhindoust teaches wherein the information received from the tag includes printing preferences (changing position of the print preferences by the user.

With respect to claim 3, Shanhindoust teaches the tag is related to the print job, see para. 23, lines 4-8 and 15-19. See also para. 21, lines 8-14.

With respect to claim 4, Shanhindoust the tag information is necessary to complete the job, see para. 23, lines 4-8 and 15-19.

With respect to claim 5, Shanhindoust teaches wherein the tag contains decryption key (inherent with respect to the authentication module 112).

With respect to claim 8, Shanhindoust teaches wherein scanning includes sending a signal to the tag (see para. 17, lines 15-18) and receiving a signal (authentication module 112) containing information from the tag about the tag.

With respect to claim 11, Shanhindoust teaches the device is a scanner (copier, see para. 17, line 28).

With respect to claim 12, see para. 17, lines 13-28.

With respect to claim 15, Shanhindoust teaches a method for transferring documents from one location to another, comprising: sending (step 321) at least one document to a queue of a printing device 114 having transmitting capabilities (either as a fax or as to printing documents to the printing device 114; bringing an electronic tag (smart card 102) containing information regarding the print job into close proximity to the tag reader operable to connect to the device having document transmission capabilities (step 313, either as a fax machine or as a printing device, see para. 17, line 28); using the information received from the tag to complete the print job, see para. 17, lines 18-28.

With respect to claim 16, Shanhindoust teaches wherein the information received by the device includes a fax number to which the job is sent. This limitation is anticipated by para. 17, lines 18-28. via the multi-peripheral device is a fax number having a fax number were the numbers are discussed at lines 18-23.

With respect to claim 18, Shanhindoust teaches a system for generating an advertisement (print job), comprising: a tag (102) encoded with advertising information; a tag reading device (GL 1010120, see step 313 in figure 3) for reading the tag and receiving the advertising information therefrom; an output device (printer 114) operable to connect to the tag reading device, wherein the output device generates the advertisement.

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With respect to claim 19, Shanhindoust teaches a printing device 114 as claimed, see col. 17, lines 25-28.

With respect to claim 20, Shanhindoust teaches wherein the output device includes a fax machine (this is anticipated by the multifunctional peripheral device, see paragraph 17, lines 25-28).

With respect to claim 21, Shanhindoust teaches the output is connected to the Internet. This is at least suggested by connection to Blue-Tooth technology.

With respect to claim 22, it is inherent that the Smart Card 102 can be inserted into a user's shirt or blouse pocket (which is a type of **container**).

4.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanhindoust in view of Yajima et al.

With respect to claims 6 and 7, Shanhindoust teaches all of the subject matter upon which the claim depends except for the tag being utilized in a cell phone or PDA device.

Shanhindoust teaches that the tag (card 102) is the device that is linked to the print job. The card can conceivably attached by Velcro or snap so that the user of such electronic devices can scan them over the print device to inform such print device regarding the information which is on the smart card as is done by Shanhindoust.

Therefore, it would have been obvious to one of ordinary skill in the art to associated a smart card with an electronic device so that one carrying such devices may conveniently scan them over the printer to affect a print job just as the scan card 102 is swiped over the printer to affect a print operation.

With respect to claims 9 and 10, see figure 1 where wireless signals are transmitted. Although it cannot be determined if the wireless signals are radio or infrared, it would have been obvious to one of ordinary skill in the art to transmit wireless signals in a frequency that is convenient as a matter of choice, whether radio, infrared, microwave or giga-wave. One of ordinary skill would have known to transmit in a frequency range that is convenient for the application designed.

5.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanhindoust in view of Harrison.

With respect to claims 13 and 14, Shanhindoust and Harrison teach the use of codes in order to communicate information about the print job from the tag to the printer. However, the utilization of bar codes or glyph codes is not specifically stated.

Harrison appears to show a glyph or bar code 32 for controlling a print job.

The use of barcodes and glyph codes are well known in the art for sending information in a machine readable fashion for performing a specific task.

Hence, it would have been obvious to one of ordinary skill in the art to use these specific machine codes for controlling the print operation.

With respect to claim 17, the email address may be sent through blue tooth technology which is well known in the communication art. Shanhindoust suggests the use of communication using this technology.

6. Examiner's Remarks

With respect to applicant's remarks found on the first page, applicant states that the Examiner has not articulated how a bar code could be the basis for a 112 rejection. In response thereto, the 112 rejection was made for the reason that the use of bar codes and glyph codes were not adequately disclosed in the written specification as to enable use of it as tag information which was also disclosed in the written specification.

In the fourth full paragraph of the argument claims 16 and 17 were also rejected and applicant stated that the present invention envisioned storing one or more fax numbers and/or e-mail addresses on a tag that would be scanned by a device and used

to complete the transmission of the document. But there is no support in the specification for what applicants have envisioned. Where specifically is there support for what applicant has alleged as what is envisioned ?

In the last paragraph of page 1 and bridging page 2 of the Remarks, as pertains to claim 21, applicant contends that applicant is not claiming sending raw tag information over the Internet other than as part of a print job, but that the tag information may be communicated over the internet if generated over the internet.

The examiner disagrees. The read devices are connected to the output device which is connected to the Internet. Hence, tag information is transmitted over the Internet. How can the advertisement data be generated from an output device when the tag has been previously generated with advertisement information ? See the last limitation of claim 18.

With respect to the second page of the Remarks, addressing the 102 rejection, the applicant contends that the examiner has not shown that Shahindoust discloses, for example, incorporating information received from a tag into a print job. Applicant's response appears to be merely an allegation for the reason the applicant has not answered by smart card 102 is not the tag with the data to be incorporated to the print job. See para. 17, lines 18-28 of the reference. The applicant has not presented an argument regarding the sections relied upon as support by the examiner.

With respect to page 3 of the Remarks and page 7 of the Response, in the second full paragraph, the examiner is urged to withdraw the rejection because Shahindoust does not use tag information to transmit a document. The remarks do not challenge para. 17, lines 18-28, which the examiner relied upon as support that the limitation had been addressed.

In the last paragraph of the third page of the Remarks, the applicant argues that Shahindoust does not teach using information stored on the Bluetooth card which is used for a print job. The examiner contends that applicant's statements are merely allegations and that no reference to para. 17, lines 18-28 have been addressed.

At page 4 of the Remarks, addressing claims 6, 7, 9, 10, 13 -15 and 17, applicant contends that Shahindoust does not incorporate subject matter from a tag into a print job. The limitation is not fully disclosed in the written specification and would amount to extensive experimentation to prove the result of using tag information to affect a print job.

7.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.- Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jerome Grant II/

Primary Examiner, Art Unit 2625